

## II. REMARKS

The Office Action dated August 16, 2006 and the references cited therein have been carefully reviewed. Reconsideration and reexamination of this application in view of the above amendments and the following remarks is herein respectfully requested. After entering these amendments, claims 1-20 remain pending.

### ***A. Objection to the Specification***

The Examiner notes use of the trademark MACHANICAL DIOLE <sup>TM</sup> in the subject application and requires that the trademark be capitalized wherever it appears and be accompanied by the generic terminology. See Office Action Dated August 16, 2006, at 2. Applicants have reviewed the specification in its entirety and cannot find the use of the trademark MACHANICAL DIOLE <sup>TM</sup>. Applicants acknowledge use of the generic term "mechanical diode" in the specification; however, this term is not a trademark and, hence, is not referenced as a trademark in the application.

### ***B. Claim Rejections***

#### ***1. 35 U.S.C. § 112***

Claims 1-11, 13-19, and 20 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention.

The Examiner states that the claimed limitation "a first rotating input clutch operatively engageable with the input shaft for enabling the input shaft to carry torque into the transmission, wherein said first rotating input clutch is slipped for launching the vehicle in first speed", as set forth in claims 1, 13, and 20, is inaccurate because, as disclosed in Figs. 1 and 2, the first rotating input clutch is located after the input torque from the input shaft passing through the first planetary gear set of the transmission. See Office Action Dated August 16, 2006, at 3-6.

Claims 1, 13, and 20 have been amended for clarification. More specifically, claims 1, 13, and 20 now recite "a first rotating input clutch operatively engageable with one of said planetary gear sets which is directly connected with said input shaft for enabling the input shaft to carry torque into the transmission, wherein said first rotating

input clutch is slipped for launching the vehicle in first speed". The first rotating input clutch, when actuated, enables torque transfer into the transmission through the first planetary gear set 20 (for example, referring to Figure 1), which is directly connected to the input shaft 17. In the preferred embodiment, the input shaft is connected to the ring gear member of the first planetary gear set, and the first and second rotating input clutches are connected to the planet carrier assembly member of the first planetary gear set. Without one of the input clutches engaged, at least one element of the first planetary gear set will simply freewheel; consequently, the input shaft would be incapable of carrying torque into the transmission. A similar amendment has been made to clarify the second input clutch language in claims 1, 13, and 20.

Accordingly, reconsideration of the § 112, ¶2, rejections of claims 1, 13, and 20 is respectfully requested. Additionally, claims 2-11 depend directly from claim 1, and claims 14-19 depend directly from claim 13. Therefore, the limitations from claim 1 are also incorporated into claims 2-11, and the limitations from claim 13 are also incorporated into claims 14-19. As such, reconsideration of the § 112, ¶2, rejections of claims 2-11 and 14-19 are also respectfully requested.

## 2. 35 U.S.C. § 102

For a rejection to be proper under 35 U.S.C. § 102(b), every element and limitation found in the rejected claim must be found in the cited § 102(b) reference. See MPEP § 2131. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." Id. Citing Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Although identity of terminology is not required, "[t]he identical invention must be shown in as complete detail as is contained in the ... [rejected] claim." Id. Citing Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Claim 12 stands rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 4,347,763, to Sakakibara et al. ("Sakakibara").

Claim 12, as previously presented, recites "a selectable reversible braking one-way clutch for braking rotation of one of said members of said planetary gear sets when

the transmission is in one of reverse and first speed, and disengaged in all other gear states". The Examiner interprets the claimed selectable reversible braking one-way clutch as a one-way clutch that is capable of operating in two opposite directions, wherein when the one-way clutch is selected to operate in a first direction, the one-way clutch is in an overrunning mode, and when the one-way clutch is selected to operate in a second direction, opposite to the first direction, the one-way clutch is in a braking mode. See Office Action Dated August 16, 2006, at 7. Applicants respectfully submit that the Examiner's interpretation of the selectable braking one-way clutch as recited in claim 12 is erroneous.

However, Claim 12 has been amended for clarification to speed prosecution. More specifically, claim 12 now includes the limitation "said selectable braking one-way clutch is configured to freewheel in one rotational direction and to brake in an opposite rotational direction, and is selectively reversible to brake in said one rotational direction and freewheel in said opposite rotational direction, thereby facilitating use in said reverse and forward speeds." Applicants acknowledge that the transmission recited in Sakakibara includes a one-way brake 64; however, according to Figure 1, and as described in Column 2, lines 53-62 and Table 1, of Sakakibara, the one-way brake 64 is not capable of being selectively actuated to brake in either a first or a second rotational direction or being selectively actuated to freewheel in either a first or a second rotational direction, and is not selectively operable when the transmission is in both reverse and first speed.

In light of the above arguments and amendments, reconsideration of the § 102(b) rejection of claim 12 based on the Sakakibara reference is herein respectfully requested.

Claim 12 also stands rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,139,463, to Kasuya et al. ("Kasuya").

Applicants respectfully submit that the Examiner's interpretation of the claimed selectable reversible braking one-way clutch is erroneous. Claim 12 has been amended for clarification to speed prosecution (see discussion set forth above.) Applicants acknowledge that the transmission recited in Kasuya includes a one-way clutch F-2, which acts as a frictional engagement element, operating to perform the same function as a one-way brake B-3. However, according to Figures 1 and 3, and as

described in Column 7, lines 40-56, and Column 9, lines 9-40, of Kasuya, the one-way clutch F-2 is not capable of being selectively actuated to brake in either a first or a second rotational direction or being selectively actuated to freewheel in either a first or a second rotational direction, and is not selectively operable when the transmission is in both reverse and first speed.

Accordingly, reconsideration of the § 102(b) rejection of claim 12 based on the Kasuya reference is respectfully requested.

### 3. 35 U.S.C. § 103

A proper rejection under 35 U.S.C. § 103(a) requires that the Examiner establish *prima facie* obviousness. As recited in the MPEP, “[t]he examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness.” MPEP § 2142. Three basic criteria must be met to establish a *prima facie* case of obviousness:

[f]irst, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

MPEP § 2143. If the Examiner fails to produce a *prima facie* case, Applicants are under no obligation to submit evidence of nonobviousness. See MPEP § 2142.

Claims 1-5, 8, 10, and 11 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kasuya in view of German document VDI-Berichte 1610 (“German ‘1610”).

Applicants respectfully submit that *prima facie* obviousness has not been established for claim 1 because the third criterion for establishing *prima facie* obviousness is not satisfied. More specifically, Kasuya, individually, and when combined with German ‘1610, fails to teach or suggest all of the elements and limitations as set forth in claim 1, namely a selectable braking one-way clutch for braking rotation of one of the members of one of the plurality of planetary gear sets when the transmission is in one of reverse and first speed. As stated above, the one-way clutch F-2 recited in Kasuya acts as a one-way frictional brake, actuated to engage

a carrier C3 of a gear set G with a transmission case 10 in the first speed only. The Examiner's suggested combination of Kasuya in view of German '1610 - to modify Kasuya such that the reference torque converter 2 is replaced by an isolation damper – does not cure the aforementioned omission, and is thus insufficient to render claim 1 obvious.

In light of the above discussion and amendments, reconsideration of the § 103(a) rejection of claim 1 based on Kasuya in view of German '1610 is respectfully requested. Additionally, claims 2-5, 8, 10, and 11 depend directly from claim 1. As such, the limitations from claim 1 are also incorporated into claims 2-5, 8, 10, and 11. Therefore, reconsideration of the § 103(a) rejection of claims 2-5, 8, 10, and 11 based on Kasuya in view of German '1610 is also respectfully requested.

Claims 13-17 and 19 also stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kasuya in view of German '1610.

Applicants respectfully submit that *prima facie* obviousness has not been established for claim 12 because the third criterion for establishing *prima facie* obviousness is not satisfied. More specifically, Kasuya, individually, and when combined with German '1610, fails to teach or suggest all of the elements and limitations as set forth in claim 12, namely a selectable reversible braking one-way clutch for braking rotation of one of the members of one of the plurality of planetary gear sets when the transmission is in one of reverse and first speed. The selectable braking one-way clutch as presented in claim 12 is configured to freewheel in a first rotational direction and to brake in a second opposite rotational direction, and is selectively reversible to brake in said first rotational direction and freewheel in said second rotational direction, thereby facilitating use in both the reverse and forward speeds. The one-way clutch F-2 recited in Kasuya is not capable of being selectively actuated to brake in either a first or a second rotational direction or being selectively actuated to freewheel in either a first or a second rotational direction, and is not selectively operable when the transmission is in both reverse and first speed. Examiner's suggested combination of Kasuya in view of German '1610, as set forth above, does not cure the aforementioned omission, and is thus insufficient to render claim 12 obvious.

In light of the above discussion and amendments, it is believed that the references cited by examiner, either individually or collectively, fail to teach all the elements and limitations of claim 12. Because claims 13-17 and 19 depend directly from claim 12, the limitations from claim 12 are incorporated into claims 13-17 and 19. Therefore, reconsideration of the § 103(a) rejection of claims 13-17 and 19 based on Kasuya in view of German '1610 is respectfully requested.

Claim 20 also stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Kasuya in view of German '1610.

Applicants respectfully submit that *prima facie* obviousness has not been established for claim 20 because the third criterion for establishing *prima facie* obviousness is not satisfied. More specifically, Kasuya, individually, and when combined with German '1610, fails to teach or suggest all of the elements and limitations as set forth in claim 20, namely a selectable braking one-way clutch for braking rotation of one of the members of one of the plurality of planetary gear sets when the transmission is in one of reverse and first speed. As stated above, the one-way clutch F-2 recited in Kasuya acts as a one-way frictional brake, actuated to engage a carrier C3 of a gear set G with a transmission case 10 in the first speed only. The Examiner's suggested combination of Kasuya in view of German '1610 - to modify Kasuya such that the reference torque converter 2 is replaced by an isolation damper - does not cure the aforementioned omission, and is thus insufficient to render claim 20 obvious.

In light of the above discussion and amendments, reconsideration of the § 103(a) rejection of claim 20 based on Kasuya in view of German '1610 is respectfully requested.

Claims 6, 7, 9 and 18, stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kasuya in view of German '1610 as applied to claims 1-5, 8, 10, 11, 13-17, 19, and 20 above, and further in view of U.S. Patent No. 7,052,430 to Stevenson et al. ("Stevenson").

According to 35 U.S.C. § 103(c)(1):

Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the

subject matter and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Applicants submit that Stevenson is subject to § 103(c) and, thus, may not be used as a basis for rejection under § 103(a). Applicants first note that Stevenson has a common inventor with the instant application, namely Scott H. Wittkopp. In addition, although Stevenson was not filed until June 7, 2004, the effective filing date of Stevenson, as a division of U.S. Application Ser. No. 10/295,120, is earlier than the subject application. See MPEP § 706.02(V)(A). Based upon the earlier effective U.S. filing date of the Stevenson reference, it constitutes prior art only under 35 U.S.C. § 102(e).

Finally, according to MPEP 706.02(I)(2)II, “[a]pplications and references (whether patents, patent applications, patent application publications, etc.) will be considered by the examiner to be owned by, or subject to an obligation of assignment to the same person, at the time the invention was made, if the applicant(s) or an attorney or agent of record makes a statement to the effect that the application and the reference were, at the time the invention was made, owned by, or subject to an obligation of assignment to, the same person.” Accordingly, the undersigned attorney hereby states:

Statement of Common Ownership - At the time the subject invention was made, the subject application and the cited reference U.S. Patent No. 7,052,430 to Stevenson et al. were owned by, or subject to an obligation of assignment to, the same person (General Motors Corporation). Therefore, U.S. Patent No. 7,052,430 is disqualified under §103(c).

In light of the above arguments, the § 103(a) rejection of claims 6, 7, 9 and 18, based on Kasuya in view of German ‘1610, and further in view of Stevenson is believed to be improper and should be withdrawn.

### III. CONCLUSION

In view of the above amendments and remarks, this paper is believed to be fully responsive to the Office Action dated August 16, 2006. The remarks in support of the rejected claims are believed to place this application in condition for allowance, which action is respectfully requested.

Please charge any fees associated with this amendment to deposit account 07-0960.

Respectfully submitted,

**SAMIE ET AL.**

By: 

Christopher W. Quinn  
Reg. No. 38,274

Date: 9/20/06

QUINN LAW GROUP, PLLC  
39555 Orchard Hill Place, Suite 520  
Novi, Michigan 48375  
Phone: 248-380-9300  
Fax: 248-380-8968

*On behalf of:*

Kathryn Marra, Esq  
GENERAL MOTORS CORPORATION  
Legal Staff Mail Code 482-C23-B21  
P.O. Box 300  
Detroit, Michigan 48265-3000